

REMARKS

Applicant hereby elect Group 1, species A, claims 1-15 with traverse.

Applicant hereby traverses the division of group 1 (claims 1-15, 21-32) into species A and B on the grounds that the restriction requirement is improper. There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 -§ 806.05(i)); and (B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) -§ 806.04(i), § 808.01(a), and § 808.02).

Applicant first considers Element A, whether the claims are directed to independent or distinct inventions. The term “independent” (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process (MPEP § 802.01). In the instant case, all limitations of dependent claims 1 and 21 are described as features of the embodiment claimed in claim 1. Accordingly, claims 1-15, 21-32 are not independent.

The term “distinct” means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art) (MPEP § 802.01). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects. In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated. To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search. See MPEP § 808.02. The inventions are distinct if it can be shown that a combination as claimed:

- (A) does not require the particulars of the sub-combination as claimed for patentability (to show novelty and unobviousness), and
- (B) the subcombination can be shown to have utility either by itself or in other and different relations.

When these factors cannot be shown, such inventions are not distinct (MPEP § 806.05(c)).

Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases. Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement. (MPEP § 803).

In the instant case, Applicant traverses on the grounds that claim 1 is a generic claim. Independent claim 21 contains all limitations of claim 1, and so claim 1 is generic to claims 21-32. Accordingly claims 1-15 and 21-32 should be examined together.

Finally, Applicants reserve the right to request review of the restriction requirement if the restriction requirement is not withdrawn. The propriety of a requirement to restrict, if traversed, is reviewable by petition under 37 CFR 1.144. *In re Hengehold*, 440 F.2d 1395, 169 USPQ 473 (CCPA 1971).

Should the Examiner wish to discuss this matter further, the Examiner is invited to call the undersigned at (408) 971-2573. For payment of any fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-2587 (Order No. SJO920020123US1).

Respectfully submitted,

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